

Remarks/Arguments:

Claim 1, currently amended, is pending.

Claim 2 is canceled, without prejudice or disclaimer.

Claims 1 and 2 are rejected under 35 U.S.C. §102(b) as being allegedly anticipated by Yamanaka (US 5,314,941). Claims 1 and 2 are rejected under 35 U.S.C. §102(b) as being allegedly anticipated by Kushida (US 5,344,864). Claims 1 and 2 are rejected under 35 U.S.C. §102(b) as being allegedly anticipated by Oshima (US 5,484,844). Reconsideration of the rejections is requested, in view of the aforesaid amendments to the claims.

For anticipation under §102 to exist, each and every claim limitation, as arranged in the claim, must be found in a single prior art reference. *Jamesbury Corp. v. Litton Industrial Products, Inc.*, 225 USPQ 253 (Fed. Cir. 1985). The "absence" from a prior art reference of a single claim limitation "negates anticipation." *Kolster Speedsteel A B v. Crucible Inc.*, 230 USPQ 81, 84 (Fed. Cir. 1986). To anticipate the claim, each claim limitation must "*identically* appear" in the reference disclosure. *Gechter v. Davidson*, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997) (*emphasis added*). To be novelty defeating, a reference must put the public in possession of the identical invention claimed. *In re Donahue*, 226 USPQ 619 (Fed. Cir. 1985).

By the instant amendment, claim 1 contains the transitional phrase "consisting of." When used as the *transitional phrase* of a claim, "consisting of" excludes non-recited elements from the literal scope of the claim. *In re Janakirma-Rao*, 135 USPQ 893 (CCPA 1963).

Present claim 1 provides (emphasis added):

An adhesive sealant ... consisting of a rubber component, a plasticizer, an antioxidant, and a filler

As such, a limitation on the "sealant" of present claim 1 is the exclusion of an element (i.e., component) other than "a rubber component, a plasticizer, an antioxidant, and a filler." *Janakirma-Rao*.

As opposed to the presently claimed "sealant," a chlorine-based polymer is included as an indispensable component of the compositions disclosed in the cited references. The "absence" from each of the cited references of a limitation on present claim 1—i.e., the exclusion of a component other than *a rubber component, a plasticizer, an antioxidant, and a filler*—"negates anticipation" of present claim 1 by any one of the cited references. *Kolster Speedsteel A B*, 230 USPQ at 84. Since none of the cited references puts the public in possession of the *identical* invention presently claimed, none of the cited references constitutes an anticipation of the presently claimed invention. *Donahue, supra*.

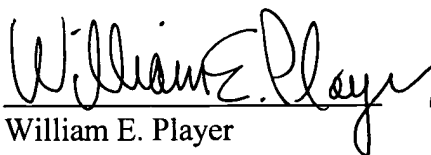
Applicants also wish to point out that the aforesaid difference between the presently claimed invention and each of the cited references allows the presently claimed "sealant" to exhibit the performance characteristics required of a *sealant* for automobile doors at an occasion of positioning or maintenance wherein any repeated operation of attachment and detachment at normal temperature is available. The presently claimed "sealant" is also advantageous in terms of environment safety, since it does not contain a chlorine-based material or solvent.

In view of the foregoing amendments and remarks, each of the rejection of claim 1 under §102(b) as allegedly anticipated by Yamanaka, the rejection of claim 1 under §102(b) as allegedly

anticipated by Kushida, and the rejection of claim 1 under §102(b) as allegedly anticipated by Oshima is overcome. Withdrawal of the rejections appears to be in order.

Favorable action is requested.

Respectfully submitted,

A handwritten signature in black ink, reading "William E. Player", written over a horizontal line.

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